

REMARKS

The claims have been amended to more clearly define the invention as disclosed in the written description. In particular, claim 7 has been amended for clarity.

Applicant believes that the above changes answer the Examiner's objection to claim 7, and respectfully requests withdrawal thereof.

The Examiner has rejected claims 1 and 14 under 35 U.S.C. 102(b) as being anticipated by European Patent No. EP0782139 to Nielsen et al. The Examiner has further rejected claim 11 under 35 U.S.C. 102(b) as being anticipated by International Patent Application No. WO 92/22983 to Browne et al. In addition, the Examiner has rejected claims 2, 4-6 and 16 under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al. in view of Browne et al. Moreover, the Examiner has rejected claims 3, 7, 8, 15 and 17 under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al. in view of Browne et al., and further in view of U.S. Patent Application Publication No. 2002/01999194 to Ali. Furthermore, the Examiner has rejected claim 9 under 35 U.S.C. 103(a) as being un patentable over Nielsen et al. in view of Browne et al., and further in view of U.S. Patent Application Publication No. 2003/0081937 to Li. Finally, the Examiner has rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al. in view of Browne et al. and Ali, and further in view of Applicant's Admitted Prior Art, where a broadcaster "pays per recording of said third type of programmes for advertisement services."

The Nielsen et al. patent discloses video management systems, in which a first videostream carrying a program for viewing is transmitted with a second videostream carrying highlights of the program in the first video stream, in which, when the user is unable to view at least a portion of the program, the user may record the highlights video stream.

The Examiner has indicated that Nielsen et al. "discloses a method of recording and playing back content to and from a personal video recorder for audio-visual content (Fig. 1), said personal video recorder having a storage medium for recording television programs (column 1, line 50- column 2, line 15; column 4, lines 32-49), and for presenting information concerning the recorded content on said recorder (column 1, line 50 - column 2, line 15; column 4, lines 50-56), comprising the steps of: recording programs of at least a first type of programs on said storage medium of the recorder, wherein said first type of programs comprises programs explicitly subscribed to on a video-on-demand system by a user of the personal video recorder (column 1, lines 20-53; column 4, lines 32-49); presenting the recorded programs in a summarised form in a User Interface (column 2, lines 41-52); and playing back a program chosen by the user, wherein the chosen program is one of the above recorded programs of at least said first type of programs (column 2, lines 41-52, ' column 4, lines 50-56)."

As noted in MPEP §2131, it is well-founded that "A claim is anticipated only if each and every element as set forth in the

claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant believes that the Examiner is mistaken. In particular, as claimed in claim 1, the subject invention includes "recording programs of at least a first type of programs on said storage medium of the recorder, wherein said first type of programs comprises programs explicitly subscribed to on a video-on-demand system by a user of the personal video recorder". Nielsen et al., at col. 1, lines 49-53, states:

"An improved videostream management system can be is provided by embodiments of the present invention. According to a specific embodiment of the invention, a videostream broadcast or recording includes a relevance level indicator",

and at col. 4, lines 32-49, states:

"The user site receives the videostream and the relevance level at a system 107. A selection system 109 (using, for example, a microprocessor programmable logic device) determines if the user has set the system into a mode for recordation of highlights. If not, the videostream is passed directly to the display 111 which may be adapted, for example, to display an NTSC videostream. If the user has set the system into a mode for recordation of highlights, the videostream or parts of the videostream are passed to a recording device 113. Recording device 113 is, in some embodiments, a videotape recorder or optical disk system. In other embodiments, particularly those related to the distribution of a videostream in a computer network, the recording device is a computer hard disk or optical

disk. Software for performing the operations herein is stored on memory 110 such as a ROM, RAM, EPROM, or magnetic or optical disk."

Applicants submit that while Nielsen et al. discloses the recording of programs or of highlights of a program, there is no disclosure or suggestion of "recording programs of at least a first type of programs on said storage medium of the recorder, wherein said first type of programs comprises programs explicitly subscribed to on a video-on-demand system by a user of the personal video recorder".

The Examiner now states "Nielsen discloses a system improved over existing systems that users explicitly subscribe to receive video on demand programs (see at least column 1, lines 20-48). As such, the programs to be recorded described therein comprise those are explicitly subscribed."

Applicant submits that the Examiner is mis-reading Nielsen et al. In particular, Nielsen et al., at col. 1, lines 23-26, states:

"Conversely, television systems already exist that can display video on demand, provide sophisticated schedule data sorting, and other traditionally computer-related functions."

While Nielsen et al. states, at col 1, lines 32-35, "Often a user wishes to be brought "up-to-date" on the events that take place in the user's absence without the need to review, for example, a video tape covering the entire user's absence", there is no disclosure as to how such a video tape is acquired. Arguably,

the user may need to go to a store and purchase the video tape of the program to see what the user missed.

Applicant submits that the Examiner is assuming that the prior art systems described in Nielsen et al. enable the user to record video-on-demand program. However, this assumption by the Examiner cannot meet the court's precept: "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1 further includes the limitation "presenting the recorded programs in a summarised form in a User Interface".

Nielsen et al., at col. 2, lines 41-52, states:

"When the user returns, a portion of the videostream has been recorded, and may be reviewed at the user's leisure. The system desirably presents the user with a menu showing, among other things, the number of events that exceed a set relevance level, the number of minutes of video exceeding a set relevance level, and how many minutes the user desires to use to review the missed video. In the simplest embodiments, the system may simply play back all video above a threshold relevance level. In other embodiments the system may adjust the relevance level of the video to be played to "fit" it into a fixed playback time."

It should be apparent from the above that the Nielsen et al. system has some form of user interface that presents the user with a menu relating to the recorded program. However, there is no disclosure or suggestion of "presenting the recorded programs in a summarised form in a User Interface".

The Examiner now states "The information presented to users as described in column 2, lines 41-52 is clearly a

summarization of the recorded programs (e.g. at least information such as the number of events that exceed a set relevance level, the number of minutes of video exceeding a set relevance level is a summarized form of the recorded program). Further, at least in column 3, lines 4-19, Nielsen also teaches that the recorded programs are displayed in a highlight review mode in which not the whole programs are displayed but only portions selected based on a threshold relevance level are displayed. Clearly, as such, Nielsen does teach the feature of "presenting the recorded programs in a summarized form in a User Interface."

Applicant submits that what is being presented by Nielsen et al. is a listing of statistics related to the recorded programs. However, this listing of statistics does not give the user any clue as to the content of the recorded programs. According to Webster's Third New International Dictionary, 1976, "summary" is defined as "1a: constituting or containing a summing up of points : covering the main points concisely : summarizing very briefly...a short restatement of the main points (as of an argument) for easier remembering, for better understanding, or for showing the relation of the points...." Applicant urges that the listing of statistics in Nielsen et al. does not satisfy that what is generally considered a "summary".

The Browne et al. patent discloses a large capacity, random access, multi-source recorder player, in which, using a user interface, the user is able to select a program to be recorded.

With regard to claim 11, the Examiner has indicated that Browne et al. discloses "a user interface for a personal video recording system, wherein information is presented to a user, said user interface comprising a first user interface for subscribing to programmes for recording (p.22-p. 24, line 12; Figs. 4-5)".

Applicant submits that the Examiner is mistaken. While Browne et al. discloses the displaying of calendars having various degrees of granularity, as well as displaying an "enter channel screen 501" in which the user selects the channel of the program to be recorded and may enter the title of the program, this is merely the selection of a program to record. There is no disclosure or suggestion of enabling a user to subscribe to a program for recording. Applicant submits that there is a distinction between the selection of a program and the subscription to a program, which would indicate entitlement to the program. In particular, as described in the specification on page 6, lines 12-19, by subscribing to the programs, if the storage medium gets destroyed, the subscribed-to programs may be recovered by re-recording the programs, e.g., when they are re-broadcast, or via a direct download from the broadcaster.

The Examiner now states "when users select a program for recording, they are in fact explicitly subscribing the program for recording. Also, this is a video-on-demand system because users via selecting which programs to be recorded are requesting those programs on their demand. Applicant further argues that, "there is a distinction between the selection of a program and the

subscription to a program" by citing some details from the specification. However, without admitting any deficiencies of Browne's teachings with respect to this matter, Examiner respectfully submits that at least those details are not recited in the claims thus irrelevant for the sake of arguments."

Applicant submits that when a user merely selects a program for recording, the user is taking advantage of an exception to the copyright laws allowing for the home recording of programs for private use. However, when a user "subscribes" to a program, the user gains rights to the program under the copyright laws. Further, in the above-noted Webster's Third New International Dictionary, the term "subscription" is defined as "e(2) : a purchase by prepayment of the future issues of a periodical usu. for a fixed period...." Hence, the mere scheduling to record a program cannot be equated to "subscribing to a programme".

Applicant further submits that it is indeed permissible to refer to the specification to distinguish how a term appearing in the claims is being used.

Claim 2 includes the limitation "recording a second type of programs on said storage medium of the personal video recorder, wherein said second type of programmes is chosen automatically based on a user profile of said user". While Browne et al. arguably discloses this limitation, Applicant submits that Browne et al. does not supply that which is missing from Nielsen et al., i.e., "recording programs of at least a first type of programs on said storage medium of the recorder, wherein said first type of programs

comprises programs explicitly subscribed to on a video-on-demand system by a user of the personal video recorder" and "presenting the recorded programs in a summarised form in a User Interface".

Claim 3 includes the limitation "wherein the step of presenting the recorded programs comprises indicating, on the User Interface, which of the recorded programs are based on the user's subscription, based on the user's profile, or recommended by a broadcaster".

The Ali publication discloses an intelligent system and methods of recommending media content items based on user preferences, in which a user display is provided in which a listing of programs is presented along with user ratings as differentiated from predicted ratings.

Applicant submits, however, that the display of Ali is of proposed or suggested programs prior to the programs having been recorded. Applicant stresses that there is no disclosure or suggestion in Ali that such distinctions should be made in a user interface showing the recorded programs.

Applicant further submits that Ali does not supply that which is missing from Nielsen et al. and Browne et al., i.e., "recording programs of at least a first type of programs on said storage medium of the recorder, wherein said first type of programs comprises programs explicitly subscribed to on a video-on-demand system by a user of the personal video recorder" and "presenting the recorded programs in a summarised form in a User Interface".

The Examiner now states "At least in [0090], Ali teaches that user rated-items and items with predicted ratings are both displayed, in which the user ratings are differentiated from predicted ratings through the user of distinct ratings icon. As such, user rated items are also displayed as shown in Fig. 2. Moreover, these userrated items comprise recorded and/or watched programs as described at least in [0034]."

Applicant submits that while the display of Ali may arguably list recorded programs, there is not disclosure or suggestion of the specific claim limitation "indicating, on the User Interface, which of the recorded programs are based on the user's subscription, based on the user's profile, or recommended by a broadcaster".

Claim 9 includes the limitation "wherein the step of playing back a program is on a pay-per-view basis."

The Li publication discloses summarization of video content, in which summarization functionality is provided.

The Examiner has indicated that Li discloses the claim 9 limitation and points out paragraph [0080] therein.

Applicant submits that the Examiner is mistaken. In particular, Li states:

"[0080] If a service provider has the summarization functionality in its database, it can provide users with summaries in addition to the complete video. This enables a service provider to offer to the end user a new feature that is seemingly not available nowadays: the service provider can provide the user with summaries in for example, a pay-perview basis. A

service provider may also offer MPEG-7 compliant summary descriptions that are authored using the play data generated by the invention. A provider may also use the subject matter of the invention as a tool in analyzing indexing sports content to offer a play based search and retrieval service."

It should be apparent from the above that Li describes the pay-per-view service "If a service provider has the summarization functionality in its database... (emphasis added)". However, Applicant submits that the subject invention as claimed in claim 9 relates to content already recorded on the personal video recorder. Hence, Li does not disclose or suggest the claim 9 limitation.

Applicant further submits that Li does not supply that which is missing from Nielsen et al. and Browne et al., i.e., "recording programs of at least a first type of programs on said storage medium of the recorder, wherein said first type of programs comprises programs explicitly subscribed to on a video-on-demand system by a user of the personal video recorder" and "presenting the recorded programs in a summarised form in a User Interface".

The Examiner now states "claim 9 only recites "the step of playing back a program" and not "the chosen program is played back on a pay-per-view basis". Thus, at least for that reason, the teachings of Li are correctly applied. Secondly, Li also discloses that such a summarization may be performed by the receiver (see at least [0079] and [0083]). As such, incorporating this feature into Nielsen would render the claim obvious.

Applicant submits that claim 9 is a dependent claim and depends directly from claim 1. The method as claimed in claim 1

includes the step "playing back a program chosen by the user, wherein the chosen program is one of the above recorded programs of at least said first type of programs". Clearly, in claim 9, the statement "the step of playing back a program" refers to the limitation in claim 1, in which that limitation, the playing back of a chosen video-on-demand program is on a pay-per-use basis. Applicant submits that Li merely describes obtaining summaries on a pay-per-use basis, not the claim 9 limitation "wherein the step of playing back a program is on a pay-per-view basis" which is based on the claim 1 limitation "playing back a program chosen by the user, wherein the chosen program is one of the above recorded programs of at least said first type of programs".

Claim 10 includes the limitation "wherein a broadcaster pays per recording of said third type of programs."

The Examiner has indicated that this limitation has been admitted by Applicant as being part of the prior art.

Applicant submits that while this limitation arguably has been performed in the past, this still does not negate the fact that the combination of Nielsen et al., Browne et al., Ali, and AAPA does not disclose or suggest "recording programs of at least a first type of programs on said storage medium of the recorder, wherein said first type of programs comprises programs explicitly subscribed to on a video-on-demand system by a user of the personal video recorder" and "presenting the recorded programs in a summarised form in a User Interface".

In view of the above, Applicant believes that the subject invention, as claimed, is neither anticipated nor rendered obvious by the prior art, either individually or collectively, and as such, is patentable thereover.

Applicant believes that this application, containing claims 1-11 and 14-17, is now in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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